

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

BYRNE *et al.*

Appl. No.: 09/934,121

Filed: August 21, 2001

For: **Dynamic Interactive Voice Interface**

Confirmation No.: 7730

Art Unit: 2614

Examiner: MD S. Elahee

Atty. Docket: 2222.0320000

Arguments to Accompany the Pre-Appeal Brief Request for Review

Mail Stop: AF

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby submit the following Arguments, in five (5) or less total pages, as attachment to the Pre-Appeal Brief Request for Review Form (PTO/SB/33). A Notice of Appeal is concurrently filed.

Arguments

Applicants' arguments in the Reply under 37 C.F.R. § 1.116 ("Reply"), filed in response to the final Office Action issued March 18, 2008 ("Office Action"), were not properly considered by the Examiner in the Advisory Action issued July 30, 2008 ("Advisory Action"). In particular, the response in the Advisory Action failed to adequately convey where the cited references teach or suggest enabling the user to specify individual character traits desired in a virtual host, wherein the specified character traits are used to select a consistent personality for the virtual host, as recited by each of the independent claims.

For a rejection to be legally adequate under 35 U.S.C. § 102, every claim limitation must be taught in a single reference. *PPG Industries, Inc. v. Guardian Industries Corp.*, 75 F.3d 1558, 1566 (Fed. Cir. 1996). The absence of any claimed

element from the reference negates anticipation. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1574 (Fed. Cir. 1984). For a rejection to be legally adequate under 35 U.S.C. § 103, every claim limitation must similarly be taught, or obvious to a person of ordinary skill in the art, in the combination of the references. *See Orthopedic Equipment, Inc. v. United States*, 702 F.2d 1005, 1013 (Fed. Cir. 1983).

I. Surace Does Not Teach the Specification of Individual Character Traits

The Office Action rejected independent claims 10, 56, 65, and 74 under 35 U.S.C. § 102(a) as allegedly being anticipated by U.S. Patent Application Publication No. 2005/0091056, now U.S. Patent No. 7,058,577, to Surace et al. (“Surace”), and this rejection was maintained in the Advisory Action. The rejection of these claims suggests that the subscriber in Surace has some individual character traits in mind when selecting a personality, and therefore has “specified” the character traits. (Advisory Action, p. 2). Notably, the Advisory Action refers to Surace at paragraph [0013], which states as an example, “[a] subscriber who is in a sales field may want an aggressive voice user interface with personality that puts incoming calls through,” and the subscriber can “choose the voice user interface with a personality that is best suited for the subscriber’s needs.” (Surace at [0013]).

However, the instant claims do not recite merely specifying the character traits in a vacuum. The claims recite that these individual character traits are stored “in a user profile having preference information for the user,” as recited in claims 10, 56, 65, and 74. The individual character traits are also used to then “select a consistent personality,” and further to “generat[e] the virtual host with the consistent personality in accordance with the specified character traits,” as further recited in claims 10, 56, 65, and 74.

In Surace, a subscriber is limited to available *personalities* and cannot specify *individual character traits*. Nowhere does Surace teach or suggest selecting or storing individual character traits, and then further using them to generate a virtual host in accordance with the individual character traits.

Additionally, since the subscriber in Surace “selects from several different personalities when selecting a virtual assistant” by “interview[ing] virtual assistants with different personalities,” the Subscriber in Surace is actually selecting the desired virtual assistant that is associated with a particular personality already comprising a predetermined collection of character traits. (Surace at [0013]). Nowhere, then, does Surace teach “enabling the user to specify individual character traits” and “*generating* the virtual host with the consistent personality in accordance with the specified character traits,” as recited in claims 10, 56, 65, and 74.

Moreover, as noted on page 12 of the Reply, which was not addressed in the Advisory Action and which Applicants contend renders the rejection improper, any actual specification of character traits in Surace occurs during an implementation phase, prior to any interaction by a *user* of a voice user interface. For example, FIG. 3 of Surace shows, at step 304, the selection of a personality type. Notably, an entire personality type can be defined at step 304, including such characteristics as “age, gender, education, employment history, and current employment position.” (Surace at [0043]). In this manner, an *entire* personality is defined in Surace prior to a user’s interaction with the system, adding to the limited selection of predefined personalities available to a subscriber, as discussed above. However, claims 10, 56, 65, and 74 specifically provide the functionality of specifying individual character traits to a “user” or “end user” of the voice interface, making it available at run-time.

Accordingly, Applicants submit that Surace does not teach or suggest each and every feature of independent claims 10, 56, 65, and 74, and therefore cannot be said to anticipate those claims. For at least these reasons, independent claims 10, 56, 65, and 74 are patentable over Surace. Moreover, as noted above, Applicants contend that the finality of the Office Action was improper due to its failure to address relevant arguments.

2. *The Combination of Surace with Staples, Sakurai, Eikeland, Duffy, Bijl, Wigan, and Eisen does not Supply the Missing Teaching or Suggestion*

The Office Action rejected the following claims as allegedly being obvious under 35 U.S.C. § 103(a): claims 11, 57, 66, and 75 over Surace in view of U.S. Patent No. 6,301,339 to Staples et al. ("Staples"); claims 12, 58, 67, and 76 over Surace in view of U.S. Patent No. 5,189,702 to Sakurai et al. ("Sakurai"); claims 13, 59, 68, and 77 over Surace in view of U.S. Patent No. 5,768,508 to Eikeland ("Eikeland"); claims 14, 60, 69, and 78 over Surace in view of U.S. Patent No. 5,911,043 to Duffy et al. ("Duffy"); claims 15, 61, 70, and 79 over Surace in view of U.S. Patent No. 6,366,882 to Bijl et al. ("Bijl"); and claims 16-18, 62-64, 71-73, and 80-82 over Surace in view of U.S. Patent No. 4,531,184 to Wigan et al. ("Wigan").

Staples, Sakurai, Eikeland, Duffy, Bijl, and Wigan do not overcome the deficiencies of Surace relative to independent claims 10, 56, 65, and 74 described above and the examiner does not cite them for that purpose. Claims 11-18 depend from claim 10; claims 57-64 depend from claim 56; claims 66-73 depend from claim 65; and claims 75-82 depend from claim 74. For at least these reasons, and further in view of their own features, claims 11-18, 57-64, 66-73, and 75-82 are patentable over Surace, Staples, Sakurai, Eikeland, Duffy, Bijl, and Wigan.

Claims 83-88 have been rejected under 35 U.S.C. § 103(a) as being allegedly obvious over Surace in view of U.S. Patent No. 4,964,077 to Eisen et al. ("Eisen"). Independent claims 83, 85, and 87 similarly recite, "specify[ing] individual character traits desired in a virtual host ... used to select a consistent personality for the virtual host." As noted above with regard to independent claim 10, Surace does not teach or suggest the aforementioned features of independent claims 83, 85, and 87. Eisen does not teach or suggest, and is not used by the Examiner to teach or suggest, the missing feature. Accordingly, claims 83, 85, and 87 are patentable over Surace and Eisen. Claims 84, 86, and 88 depend from claims 83, 85, and 87, respectively, and are also patentable over Surace and Eisen for at least the same reasons as claims 83, 85, and 87, and further in view of their own respective features.

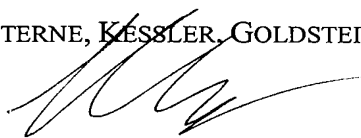
3. *Conclusion*

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 102(a) over Surace and under 35 U.S.C. § 103(a) over Surace in view of Staples, Sakurai, Eikeland, Duffy, Bijl, Wigan, and Eisen.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.


Theodore A. Wood
Attorney for Applicants
Registration No. 52,374

Date: 19 SEP 05

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600